

## **II. RESPONSE TO OFFICE ACTION**

### **I. Claims in the Case**

Claims 1, 3-9 and 11 have been amended. No claims have been added. Claims 1 – 13 are currently under examination.

### **II. Change of Address/New Assignee**

Please note that the present application has been assigned from the previous owner, Xoma, to Research Development Foundation (“RDF”). Enclosed is a Statement Under 37 C.F.R. §3.73(B) and a new Power of Attorney. Please direct all future communications to:

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### **III. Reexamination of US 6,376,217**

A patent, US 6,376,217, that is related to the present application is currently involved in an inter partes reexamination, Reexam No. 95/000,016, brought by the present assignee/Requester, RDF. All of the claims of the ‘217 patent are currently rejected over prior art. Thus, we enclose herewith a new IDS and 1449 to make of record here the art submitted in the subject reexamination. We would note, however, that the claims in the present case are distinct from those in the ‘217 application and are believed to be patentable over the art of record in the ‘016 reexamination.

### **IV. Rejection of Claims Under 35 U.S.C. §112, Second Paragraph**

The Action first rejects various of the claims under 35 U.S.C. §112, second paragraph. With respect to claims 3-9, which were rejected on the basis that the designation “he3” is a laboratory designation and thus indefinite, Applicants have removed the complained-of language from claims 3-9. Claims 1 and 11 have been amended generally as suggested, except Applicants

would prefer not to include the recommended phrase "antigen binding fragment." The reason for this is that a single chain antibody, such as set forth in claim 9, is not a "fragment" of an antibody. Applicants believe that the current language should be sufficiently definite. Nevertheless, Applicants would be pleased to entertain another suggestion.

#### **V. Double Patenting Rejections**

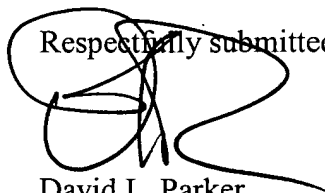
The Action next enters non-statutory double patenting rejections over US 6,649,742; US 5,621,083; US 5,744,580; US 6,376,217. While Applicant's do not necessarily agree with the rejection, particularly with respect to the '217 patent, Applicant's are willing to file and provide herewith an appropriate terminal disclaimer to obviate the rejection.

#### **VI. Conclusion**

Applicants believe that the foregoing remarks fully respond to all outstanding matters for this application. Applicants respectfully request that the rejections of all claims be withdrawn so they may pass to issuance.

Should the Examiner desire to sustain any of the rejections discussed in relation to this Response, the courtesy of a telephonic conference between the Examiner, the Examiner's supervisor, and the undersigned attorney at 512-536-3055 is respectfully requested.

Respectfully submitted,



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